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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/911,211

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Jerlyn R. Culp

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09/07/2006

## HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

SINGH, SATWANT K

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/911,211	<b>Applicant(s)</b> CULP ET AL.	
	<b>Examiner</b> Satwant K. Singh	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 11-18, 21-26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11-18, 21-26 and 29-36 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on 13 June 2006.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3, 5-8, 11-18, 21-26, and 28-36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-8, 11-18, 24-26, 31-33, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Gatto et al. (US 2002/0174444).
5. Regarding Claim 1, Gatto et al disclose a method comprising: automatically detecting an object to be scanned by a scanner associated with an Internet receiver (scanning ticket 530); scanning the object to produce an image of the object (presenting ticket 530 in front of an illuminated window); automatically acquiring said image in electronic format (barcode reader may display, print etc information related to the transaction on their TV); performing, by the Internet receiver, at least one function with said image in said electronic format (barcode reader may display, print etc information

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related to the transaction on their TV); and acquiring a final scan by the scanner of said image after performing said at least one function (provide information to the transaction on their TV or computer monitor) (page 6, paragraph [0084]).

6. Regarding Claim 2, Gatto et al disclose a method, wherein performing said at least one function comprises automatically performing at least one pre-selected function (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

7. Regarding Claim 3, Gatto et al disclose a method, further comprising manually selecting said at least one function (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

8. Regarding Claim 5, Gatto et al disclose a method, wherein performing said at least one function comprises performing at least one of the following functions: editing said image in said electronic format, displaying said image in said electronic format, and transmitting said image in said electronic format over a network (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

9. Regarding Claim 5, Gatto et al disclose a system comprising: an Internet receiver (Fig. 5, STB 100); a scanner linked to said Internet receiver (Fig. 5, barcode reader 532), said scanner to scan an object and to produce an image of the scanned object in electronic format (scanning ticket 530), wherein the Internet receiver comprises a bay in which the scanner is insertable by a user (barcode reader is integrated within the STB) (page 6, paragraph [0084]); a control module for said Internet receiver (Fig. 9, controller

900) (page 6, paragraph [0086]), comprising: computer readable storage media (Fig. 9, memory 904) (page 6, paragraph [0086]); computer readable program code stored on said computer readable storage media, comprising: program code for receiving said image in said electronic format from said scanner (scanning ticket 530); and program code for performing at least one function with said image in said electronic format via said Internet receiver (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

10. Regarding Claim 7, Gatto et al disclose a system, wherein said scanner is linked to said Internet receiver via a unidirectional link (scanning ticket 530).

11. Regarding Claim 8, Gatto et al disclose a system, wherein said scanner is linked to said Internet receiver via a bi-directional link (scanning and printing ticket 530).

12. Regarding Claim 11, Gatto et al disclose a system, further comprising program code for automatically setting-up said scanner for operation via said Internet receiver (barcode reader integrated within STB).

13. Regarding Claim 12, Gatto et al disclose a system, wherein at least part of said computer readable program code is downloaded to said Internet receiver from a network site on an as-needed basis (intelligent devices connected on the network) (page 5, paragraph [0076]).

14. Regarding Claim 13, Gatto et al disclose a system, wherein said computer readable program code resides at least in part at a network site to conserve memory at said Internet receiver (NVRAM 924) (pages 6 and 7, paragraph [0088]).

15. Regarding Claim 14, Gatto et al disclose a system, further comprising program code for pre-selecting said at least one function (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

16. Regarding Claim 15, Gatto et al disclose a system, further comprising program code for receiving a manual selection of said at least one function after said image is detected (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

17. Regarding Claim 15, Gatto et al disclose a system, wherein said program code for performing said at least one function comprises program code for performing at least one of the following functions: editing said image in said electronic format, displaying said image in said electronic format, and transmitting said image in said electronic format over a network (barcode reader may display, print etc information related to the transaction on their TV) (page 6, paragraph [0084]).

18. Regarding Claim 17, Gatto et al disclose a system, further comprising program code for acquiring a final scan of said image after said at least one function is performed (provide information to the transaction on their TV or computer monitor) (page 6, paragraph [0084]).

19. Regarding Claim 18, Gatto et al disclose a system, further comprising a maintenance component comprising program code for configuring said control module (Set top boxes can integrate functions found on entertainment PCs) (page 3, paragraph [0041]).

20. Regarding Claim 24, Gatto et al disclose a method, wherein automatically detecting the object comprises automatically detecting the object with at least one of a mechanical switch and a photo sensor (presenting ticket in front of an illuminated window of a barcode reader) (page 6, paragraph [0084]).
21. Regarding Claim 25, Gatto et al disclose a method, further comprising presenting, in a user interface of the Internet receiver, options to perform one of manual configuration and automatic configuration of the scanner (multi headed graphics interface) (page 5, paragraph [0073]).
22. Regarding Claim 26, Gatto et al disclose a method, further comprising receiving, in a user interface of the Internet receiver, at least one of: an identifier of a website, personal information of a user, a setting to indicate that the image is to be e-mailed, and a setting that the image is to be transmitted to a web page (e-mail and web browsing) (page 5, paragraph [0074]).
23. Regarding Claim 31, Gatto et al disclose an apparatus comprising; a set-top device for use with a television (STB 100) (page 5, paragraph [0073]); an Internet receiver in the set-top device (internet interface of the STB) (page 5, paragraph [0073]); a scanner physically installed in the set-top device (barcode reader integrated within the STB), the scanner to scan an object and to produce an image of the object (display information related to the transaction) (page 6, paragraph [0084]); and a user interface provided by the Internet receiver to enable user selection of a setting for communicating the image over a network, the Internet receiver to enable transmission of the image

without using a computer to transmit the image (multi headed graphics interface) (page 5, paragraph [0073]).

24. Regarding Claim 32, Gatto et al disclose an apparatus, wherein the user interface enables user selection of a setting to e-mail the image (e-mail and web browsing) (page 5, paragraph [0074]).

25. Regarding Claim 33, Gatto et al disclose an apparatus, wherein the user interface enables user selection of a setting to communicate the image to a web page (e-mail and web browsing) (page 5, paragraph [0074]).

26. Regarding Claim 36, Gatto et al disclose an apparatus, wherein the set-top device has a bay to receive the scanner (barcode reader is integrated within the STB) (page 6, paragraph [0084]).

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 21-23, 29, 30, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of Samaan et al. (US 2002/0138843).

29. Regarding Claim 21, Gatto et al fail to teach a method, wherein performing the least one function comprises edit the image.

Samaan et al teach a method, wherein performing the least one function comprises edit the image (video editing) (page 8, paragraph [0089]).



Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Gatto with the teaching of Samaan to allow a user to edit a scanned image at the STB since the STB is performing the function of a computer.

30. Regarding Claim 22, Gatto et al fail to teach a method, wherein editing the image comprises re-touching the image (video editing) (page 8, paragraph [0089]).

Samaan et al teach a method, wherein editing the image comprises re-touching the image.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Gatto with the teaching of Samaan to allow a user to edit a scanned image at the STB since the STB is performing the function of a computer.

31. Regarding Claim 23, Gatto et al fail to teach a method, wherein scanning the object comprises scanning a photograph, the produced image comprising an image of the photograph (background image is photographic) (page 6, paragraph [0073], page 7, paragraph [0078]).

Samaan et al teach a method, wherein scanning the object comprises scanning a photograph, the produced image comprising an image of the photograph.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Gatto with the teaching of Samaan to allow a user to edit a scanned image at the STB since the STB is performing the function of a computer.

32. Claims 29 and 35 are rejected for the same reason as claim 23.

33. Regarding Claim 30, Gatto et al fail to teach a system, wherein the Internet receiver comprises a user interface to enable editing of the image of the photograph.

Samaan et al teach a system, wherein the Internet receiver comprises a user interface to enable editing of the image of the photograph (video editing) (page 8, paragraph [0089]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Gatto with the teaching of Samaan to allow a user to edit a scanned image at the STB since the STB is performing the function of a computer.

34. Claim 34 is rejected for the same reason as claim 21.

#### ***Allowable Subject Matter***

35. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nishikawa et al. (US 6,348,932) discloses an integrated DSS/WebTV receiver.

Akerib (US 6,507,362) discloses a digital image generation device for transmitting digital images in platform-independent form via the Internet.

Jones (US 2001/0032335) discloses a picture communication system and associated network services.

Liu (US 2002/0033967) discloses an apparatus and method for directly uploading scanned images to associated web sites.

Zustak et al. (US 2002/0104098) discloses a subscriber class television with class member programming.

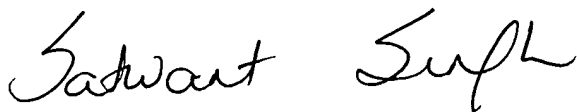
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



sks

Satwant K. Singh  
Examiner  
Art Unit 2625



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER